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EXAMINER

SHAN, APRIL YING

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/797,216	Applicant(s) HARRIS, STEVEN M.	
	Examiner APRIL Y. SHAN	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-30 is/are pending in the application.
- 4a) Of the above claim(s) 5-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3--4 and 20-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicant's amendment, filed 18 March 2008, has been received, entered into the record, and respectfully and carefully considered.
2. As a result of the amendment, claims 1, 3-4, 20 – 22 and 30 have been amended. Claim 2 is canceled. Claims 5-19 are withdrawn from consideration due to restriction/election requirement. Claims 1, 3-4 and 20 -30 have been examined.
3. Any rejection/objection not repeated below is withdrawn due to Applicant's amendment and argument.

Information Disclosure Statement

4. The information disclosure statement filed 10 March 2004 fails to comply with 37 CFR 1.98(a)(1), which requires the following: (1) a list of all patents, publications, applications, or other information submitted for consideration by the Office; (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement. **Please note on the form of PTO -1449 submitted by the Applicant on 10 March 2004, the Applicant lists no reference at all.** The information

disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Specification and claims

5. The use of the trademarks Windows operating system and Task Manager program has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.
6. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1, 3-4 and 20-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per **claim 1**, in the preamble, "...without revealing to a recipient **a password** that protects the password protected content file" is being recited. In step (a) of the claim, "...to **at least one password** corresponding to **the password** that protects the password protected content file" is being recited. It appears to the examiner, "**a password** that protects the password protected content file" in the preamble is the antecedent basis of "**the password** that protects the password protected content file" in

step (a). However, in step (b), "...wherein **the at least one password** is not revealed to the recipient" is being recited. So, which password, "a password" recited in the preamble or "at least one password" recited in step (a) or step (b) is not revealed to the recipient? Please clarify.

As per **claim 20**, "wherein **the at least one password** is not revealed to the recipient" is being recited. However, it is not clear whether this is intended to referring to "locked with at least one password" recited in line 4 of the claim or "at least one password corresponding..." recited in line 5 of the claim.

Any claim not specifically addressed, above, is being rejected as incorporating the deficiencies of a claim upon which it depends.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 20-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 20-30 are directed to an unlocking program. First, the Applicant's effort to overcome 101 rejection is acknowledged by the examiner. The amended claims are drawn to a computer-readable medium that is defined in the specification can be a communication medium, such as a signal (Page 7, paragraph 16 and 11, paragraph 23). This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, machine, manufacture, or a composition

Art Unit: 2135

of matter. Instead, it includes a form of energy. Energy does not fall within a statutory category since it is clearly not a series of steps or acts to constitute a process, not a mechanical device or combination of mechanical devices to constitute a machine, not a tangible physical article or object which is some form of matter to be a product and constitute a manufacture, and not a composition of two or more substances to constitute a composition of matter (MPEP 2106)

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 3-4 and 20-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Eller et al. (U.S. Patent No. 5,889,860).

As per **claim 1**, Eller et al. discloses a method for distributing a password protected content file without revealing the password to a recipient, comprising the steps of:

a. distributing to the recipient's computer an unlocking program having access to at least one password corresponding to the password protecting the content file (“...and is assigned a password that is specific to the client and transaction” – e.g.

abstract and “The password functions as a decryption key to enable use of the musical score by the client employing the access software” – e.g. abstract and steps 96, 98 and 102 in fig. 5. Please note a password and access software correspond to Applicant’s unlocking program);

b. distributing the password protected content file to the recipient's computer wherein upon activation the unlocking program automatically supplies the at least one password upon loading of the password protected content file (“...the server 12 distributes access software and partially encrypted musical scores to clients upon request” and “The password functions as a decryption key to enable use of the musical score by the client employing the access software” – e.g. abstract and steps 98 and 102 in fig. 5) wherein the at least one password is not revealed to the recipient (“By operation of the Music Viewer software, the client then receives (98) the password and stores the password in a password database separate from the downloaded music. It will thus be difficult for a client user to improperly redistribute music because **the user will generally not be aware that a decryption password has been stored in its system, nor will the user know how to access the password**” – e.g. 6, lines 40-47)

As per **claim 3**, Eller et al. discloses a method as applied above in claim 1. Eller et al. further discloses wherein the unlocking program is adapted to run separately from

the application program and to monitor the application program for a request for a password (step 98 and 102 in fig. 5).

As per **claim 4**, Eller et al. discloses a method as applied above in claim 1. Eller et al. further discloses wherein steps a and b are repeated at a predetermined rate and wherein the password protecting the content file and the password accessed by the unlocking program are different in each repeat cycle (“...where decryption keys are assigned on a transaction-by-transaction basis...” – e.g. col. 2, lines 48-65).

As per **claim 20**, Eller et al. discloses an unlocking program for unlocking a content file readable by an application program, the content file being locked with at least one password, the unlocking program having access to at least one password corresponding to the at least one password locking the content file and instructions to automatically supply the at least one password to the application program upon the application program loading the content file (“...and is assigned a password that is specific to the client and transaction” – e.g. abstract. Please note a password/access software correspond to Applicant’s unlocking program and step 96 in fig. 5 and “...the server 12 distributes access software and partially encrypted musical scores to clients upon request” and “The password functions as a decryption key to enable use of the musical score by the client employing the access software” – e.g. abstract and steps 98 and 102 in fig. 5).

As per **claim 21**, Eller et al. discloses an unlocking program as applied above in claim 20. Eller et al. further discloses wherein the unlocking program includes at least one instruction for initiating the application program and for causing the application program to load the content file (“...and is assigned a password that is specific to the client and transaction” – e.g. abstract. Please note a password/access software corresponds to Applicant’s unlocking program and step 96 in fig. 5 and “...the server 12 distributes access software and partially encrypted musical scores to clients upon request” and “The password functions as a decryption key to enable use of the musical score by the client employing the access software” – e.g. abstract and steps 98 and 102 in fig. 5).

As per **claim 22**, Eller et al. discloses an unlocking program as disclosed in claim 20. Eller et al. further discloses wherein the unlocking program includes means for preventing a screen capture representing at least a portion of the content stored in the content file (e.g. col. 7, lines 19-39).

As per **claim 23**, Eller et al. discloses an unlocking program as applied above in claim 20. Eller et al. further discloses wherein the unlocking program is adapted to run independently of the application program (Steps 98 and 102 in fig. 5).

As per **claim 24**, Eller et al. discloses an unlocking program as applied above in claim 20. Eller et al. further discloses wherein the unlocking program includes instructions for monitoring the running of at least one system administration program capable of terminating the unlocking program (e.g. col. 6, lines 47-60).

As per **claim 25**, Eller et al. further discloses wherein the unlocking program includes instructions for automatically terminating the system administration program upon detecting the running of such system administration program (e.g. col. 8, line 61 – col.9, line 39).

As per **claims 26 and 27**, Eller et al. further discloses wherein the unlocking program includes an instruction for terminating the application program upon detecting the running of such system administration program (e.g. col. 8, line 61 – col.9, line 39) and wherein the unlocking program includes an instruction for terminating the unlocking program after the application program has been terminated (e.g. col. 8, line 61 – col.9, line 39 and fig. 6).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 2135

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
15. Claims 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eller et al. (U.S. Patent No. 5,889,860) in view of examiner's official notice.

As per **claim 28**, Eller et al. discloses a secured computer system in fig. 1 and col. 4, lines 24-64. Eller et al. does not expressly disclose Task Manager program. However, the examiner takes official notice that Task Manager program is well known in the art and every computer has a task manager used to provide information about the processes and program running on a computer, as well as the general status of the computer. Since Eller et al. discloses a secured computer system has computers (servers and clients), it would have been obvious to a person with ordinary skill in the art that Task Manager program is included in the server and client computers of the Eller et al.'s since Task Manager program is well known in the art to provide information about the processes and programs running on a computer, as well as the general status of the computer.

As per **claim 29**, Eller et al. discloses the access program is running from beginning to the end without interruption in fig. 6 and in col. 6, line 61- col. 7, line 39. The examiner takes official notice that an instruction to prevent terminating of a program is common knowledge in the art. It would have been obvious to a person with ordinary skill in the art that there is an instruction to prevent termination of the access software since the access program is able to run from the beginning until the end without interruption with the presence of the task manager (as explained above in claim 28), which is capable of terminate programs.

As per **claim 30**, Eller et al. discloses in col. 2, lines 26 – 30, "...for example, digital sheet music,...or other subject matter transmittable in digital form". Although Eller et al. does not expressly disclose pdf format, however, the examiner takes official notice that subject matter transmittable in digital form includes pdf format is well known in the art. It would have been obvious to a person with ordinary skill in the art that content file disclosed in Eller et al. includes pdf format since pdf format has been used in the art for over fifteen years and it is well known in the art that the pdf format content file can be digitally transmitted from any application on any computer system.

Response to Arguments

16. Applicant's arguments filed 18 March 2008 have been respectfully and fully considered but they are not persuasive.

17. The Applicant argues, "Eller reference does not teach the password never be revealed to the recipient" (remark, pages 11-15), the examiner respectfully disagrees.

In col. 6, lines 40-47, Eller discloses "By operation of the Music Viewer software, the client then receives (98) the password and stores the password in a password database separate from the downloaded music. **It will thus be difficult for a client user to improperly redistribute music because the user will generally not be aware that a decryption password has been stored in its system, nor will the user know how to access the password**". Please note client and user are two different entities in the Eller reference. User in the Eller reference corresponds to Applicant's recipient. It appears to the examiner the Applicant equal Eller's client to Applicant's recipient, which is incorrect. Further, Contrary to Applicant's argument that

user access the password, Eller discloses "At this time, the Music Viewer locates the password" in col. 6, lines 50-51. In another words, in Eller reference, the user (i.e. recipient) is not able to improperly redistribute music because the password never revealed to the recipient. Furthermore, it appears to the examiner the Applicant equals Eller's View ID with Applicant's password, which is incorrect. In fact, in col. 5, col. 56 - 60, Eller discloses "For example, the key can be a password composed of two 32 bit numbers where one of the numbers is an index to identify the client in a client database and the other number is **random**, or encoded with additional information as desired".

Therefore, Eller reference does disclose the password never be revealed to the recipient.

Conclusion

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to APRIL Y. SHAN whose telephone number is (571)270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/April Y Shan/
Examiner, Art Unit 2135

/KIMYEN VU/

Supervisory Patent Examiner, Art Unit 2135